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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,509	07/17/2000	FUMITAKE YODO	6715/60188	7100
7590	11/15/2004		EXAMINER	
JAY H MAIOLI COOPER & DUNHAM 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/600,509	YODO, FUMITAKE
	Examiner	Art Unit
	Andrew J. Fischer	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 August 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,4,5 and 7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,4,5 and 7 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office Action (*i.e.* the ‘Third Final Office Action’ mailed May 18, 2004) has been withdrawn pursuant to 37 C.F.R. §1.114.

Acknowledgements

2. In accordance with the RCE noted above, Applicant’s amendment filed June 23, 2004 is acknowledged. Accordingly, claims 1, 4, 5, and 7 remain pending.

3. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

Claim Rejections - 35 USC §102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4, and 5 are rejected under 35 U.S.C. §102(e) as being anticipated by Peterson, Jr. (U.S. 5,857,020) ("Peterson '020"). Peterson '020 discloses a terminal with a first memory (memory storing 91), a second memory (memory storing 79), a first controller (94); a second controller (the digital-to-analog converter within 40); the controller reduces the accounting point information (from 91) stored in the first memory and updates the attributes of the received information from an unavailable state to an available state (decrypts the secured data making it available to the user); if the user has insufficient funds, the data is held in the unavailable state (inherent); the second controller transmits the remaining accounting point information (for an increase in funds) and the accounting point information is reset to an initial value (e.g. greater than or equal to \$5) based upon the status of the account processing (payment was received) (inherent in the "automatic Online process" at column 9, lines 44-53); and a communicator (40).

Claim Rejections - 35 USC §103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4, and 5 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson '020 in view of Kupka et. al. (U.S. 6,434,535 B1) ("Kupka").¹ It is the

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the §102 rejection.

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Examiner principle position that claims 1, 4, 5, and 6 are anticipated because of the inherencies as noted above. Alternatively, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peterson '020 as taught by Kupka and to include the missing inherencies. For example, because Peterson '020 directly discloses "automatic Online process," at column 9, ~ line 53, one of ordinary skill in the would understand the accounting center must perform at least one "accounting process based upon the accounting point information transmitted from the terminal device." It is clear to those skilled in the art that if the user had only 16¢ left in his or her account, this amount is transmitted to the accounting center via the "automatic Online process" and added to any amount additionally purchased. It is also evident that the server would store the customer's records in a central location and not just at the terminal device. "The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the unskilled reader." *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001) citing *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) ("patents are written by and for skilled artisans").²

In other words, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peterson '020 as taught by Kupka to directly include the replenishing process as shown in Kupka's Figure 8. Such a modification would have

² See also *In re Eltgroth*, 419 F.2d 918, 921, 164 USPQ 221, 223 (CCPA 1970) ("This court has often observed that minutiae of descriptions or procedures perfectly obvious to one of ordinary skill in the art yet unfamiliar to laymen need not be set forth.").

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directly disclosed at least one "automatic online process" in Peterson '020 in order to add value to the user's card.

8. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson '020 in view of Goldman (U.S. 5,629,867). Peterson '020 discloses as discussed above but does not directly disclose a third controller. Goldman teaches that although only one processor (10) is required, to provide optimum performance, a processor system using two processors (10 and 12) is preferred (column 4, lines 38-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peterson '020 as taught by Goldman to include a third controller as a redundant processor. Such a modification would have provided redundancy such that if one processor failed, the other processor could immediately take over without interruption.

Moreover, the claimed functions performed by "a third controller" in claim 7 could easily be performed by controller (32) in Peterson '020. Applicant is reminded that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 47 CCPA 771, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).³ In this case, it is the Examiner's factual determination that duplicating processors (whether its two or three processors) would not produce new or unexpected results other than to increase processing speed.

9. Claim 7 is alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over the Peterson '020/Kupka combination and in further view of Goldman. If a reviewing body finds

³ See MPEP §2144 titled "Legal Precedent Can Provide the Rational Supporting Obviousness ..." for a discussion of how legal precedent can be used as a substitute for a motivational statement in obviousness rejections.

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that claim 1 is not anticipated yet obvious in view of Goldman, then this rejection applies. All arguments noted above with respect to Goldman noted above are incorporated within this rejection as well.

Response to Arguments

10. Applicant's arguments filed June 23, 2004 have been fully considered but they are not persuasive.

11. Applicant argues "that Peterson '020 fails to show or suggest a second controller included in a terminal device for transmitting a remaining accounting point information . . ." The Examiner respectfully disagrees. Because Applicants have elected product claims, the "configured to" or "for" language is considered functional language. Applicant is then reminded that if the prior art structure is *capable of* performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Clearly the terminal device is *cable of* transmitting the remaining accounting point information. Such information would have ensured that errors were not made by reconciling the two devices.

Conclusion

12. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th

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Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (beginning on page 5) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁴ the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's

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positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.

A handwritten signature in black ink, appearing to read "AJFischer". To the right of the signature is the date "11/10/04".

Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF

November 10, 2004

⁴ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.